

## II. REMARKS

### Formal Matters

Claims 1-9, 11, 12, 14, 22, 23, and 25-37 are pending after entry of the amendments set forth herein.

Claims 1-5 and 11-13 were examined and were rejected. Claims 6-9, 14, 22, 23, and 25-29 were withdrawn from consideration.

Claims 1, 5, 11, and 12 are amended. The amendments to the claims were made solely in the interest of expediting prosecution, and are not to be construed as an acquiescence to any objection or rejection of any claim. Claims 11 and 12 are amended to change the claim dependency. Support for the amendments to claims 1 and 5 is found in the claims as originally filed, and throughout the specification, in particular at the following exemplary locations: claim 1: page 12, line 12 to page 13, line 5; and claim 5: page 12, line 12 to page 13, line 5. Accordingly, no new matter is added by these amendments.

Claim 13 is canceled without prejudice to renewal, without intent to acquiesce to any rejection, and without intent to surrender any subject matter encompassed by the canceled claim. Applicants expressly reserve the right to pursue any canceled subject matter in one or more continuation and/or divisional applications.

Claims 30-37 are added. Support for new claims 30-37 is found in the claims as originally filed, and throughout the specification, including the following exemplary locations: claims 30 and 31: page 12, line 16 to page 13, line 5; claims 32-36: page 10, line 11 to page 11, line 5; and claim 37: page 18, line 9 to page 19, line 18. Accordingly, no new matter is added by these new claims.

Applicants respectfully request reconsideration of the application in view of the remarks made herein.

### Claim objections

The Office Action objected to claims 11-13. The Office Action stated that claims 11-13 depend in the alternative from non-elected claims.

Claim 13 is canceled without prejudice to renewal, thereby rendering the objection to claim 13 moot.

Claims 11 and 12 are amended such that the claims do not depend from withdrawn claims.

Rejection under 35 U.S.C. §101

Claims 1-5 and 10 were rejected under 35 U.S.C. §101 as allegedly claiming the same invention as that of claims 1-5 and 11 of U.S. Patent No. 6,255,292.

Applicants assume that the Office Action meant to refer to U.S. Patent No. 6,225,292, and will respond accordingly.

Applicants note that claim 10 was previously canceled; therefore, the rejection of claim 10 is moot.

Claim 1 is amended to recite that the nucleic acid comprises a phosphate backbone modification. Claims 1-5 and 11 of U.S. Patent No. 6,225,292 do not recite a phosphate backbone modification. The amendment to claim 1 thus adequately addresses this rejection. Claims 2-5 depend from claim 1. Accordingly, the rejection as applied to claims 2-5 is also adequately addressed.

Applicants submit that the rejection of claims 1-5 and 10 under 35 U.S.C. §101 has been adequately addressed in view of the remarks set forth above. The Examiner is thus respectfully requested to withdraw the rejection.

Rejection under 35 U.S.C. §112, first paragraph

Claims 12 and 13 were rejected under 35 U.S.C. §112, first paragraph, as allegedly failing to comply with the enablement requirement.

The Office Action stated that the specification does not contain any data related to the ability to immuno inhibit an immune response to a gene therapy antigen or gene immunization antigen.

Claim 13 is canceled without prejudice to renewal, thereby rendering the rejection of this claim moot.

Without conceding as to the correctness of this rejection, claim 12 is amended to recite a kit “comprising a pharmaceutical composition according to any one of claims 1-5 and 11 in a sterile vial.”

Applicants submit that the rejection of claims 12 and 13 under 35 U.S.C. §112, first paragraph, has been adequately addressed in view of the remarks set forth above. The Examiner is thus respectfully requested to withdraw the rejection.

### III. CONCLUSION

Applicants submit that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-0815, order number UCAL173CON.

Respectfully submitted,  
BOZICEVIC, FIELD & FRANCIS LLP

Date: Sept. 20, 2004

By: 

Paula A. Borden  
Registration No. 42,344

BOZICEVIC, FIELD & FRANCIS LLP  
1900 University Ave., Suite 200  
East Palo Alto, CA 94303  
Telephone: (650) 327-3400  
Facsimile: (650) 327-3231